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| 10/764,157 | 01/24/2004 | Martin J. Brown JR. | 2003-0192.02 | 8159 |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>24 January 2004</u>.

2a)☐ This action is **FINAL.**     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>24 January 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

### Claim Rejections - 35 USC § 103

1.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.      Claims 1-2, 6-7, 9-12, 14-15, 17-22 are rejected under 35 U.S.C. 103(a) as being

anticipated by Takimoto (US 6,202,092) in view of Reilly (US 6,502,147).

Regarding Claim 1:

Takimoto discloses a method of printing (Column 2, lines 39-48) an image data

file on a printing device (5 in Figure 4; See embodiment described in Column 6, lines

28-32), comprising the steps of:

receiving an image data file (e.g., Data files stored in File Device 43 in Figure 4)

from an originator (e.g., Server Computer 4 in Figure 4), said image data file including at

least one originator identifier (Column 3, lines 54-58);

determining (Column 3, lines 63-66) if said at least one originator identifier

matches an authorization identifier stored in memory (File device 43 in Figure 4), said

authorization identifier corresponding to at least one enable property (Figures 3a and

3b);

printing said image data file using at least one imaging substance (e.g., Color Print, Figure 3b), said imaging substance enabled for said originator (Column 6, lines 14-23).

Takimoto does not expressly disclose wherein the server computer 4 of Figure 4 is located in the printer.

Reilly, in the same field of endeavor of network printing systems discloses wherein the print server resides within the printer (Column 1, lines 43-54).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included the server computer 4 of Figure 4 in the printer of Takimoto.

The suggestion/motivation for combining the printer and print server is to reduce the cost (Column 2, lines 40-45; Reilly).

Therefore, it would have been obvious to combine the network interface of Reilly with the network printing system of Takimoto to obtain the invention as specified in Claim 1.

Regarding Claim 2:

Takimoto discloses a method of printing of claim 1, wherein said enable property either enables or disables operation of said imaging substance for said image data file (Column 5, lines 7-15).

Regarding Claim 6:

Takimoto discloses a method of printing of claim 1, wherein said memory is a

non-volatile memory (Column 6, lines 38-41; Note: Figure 2, Steps S4, S5 and S11

clearly imply non volatile memory).

Regarding Claim 7:

Takimoto discloses a method of printing of claim 1, wherein said authorization

identifiers and said at least one enable property are stored (Column 6, lines 38-41) in a

look-up table (See Figures 3a and 3b).

Regarding Claim 9:

Takimoto discloses a method of printing of claim 1, wherein said originator

identifier includes at least one of a user identifier (Column 3, lines 54-58) and computer

identifier (Column 6, lines 59-67).

Regarding Claim 10:

Takimoto discloses a method of printing of claim 1, wherein said receiving is

received from over a network (Column 4, lines 31-36).

Regarding Claim 11:

Takimoto discloses a method of printing (Column 2, lines 39-48) using a printer

capable of printing image data and having a plurality of imaging substances comprising

the steps of:

receiving at said printer an image data file (e.g., Data files stored in File Device

43 in Figure 4), said image data file including image data and data corresponding to an

originator (e.g., Server Computer 4 in Figure 4) of said image data file;

comparing (Column 3, lines 63-66) said originator data with authorization data

stored in memory (File device 43 in Figure 4), said authorization data including at least

one authorization identifier and at least one enable property (Figures 3a and 3b) for

each authorization identifier (Column 3, lines 54-58); and

printing said data using at least one imaging substance (e.g., Color Print, Figure 3b),

said imaging substance enabled for said originator (Column 6, lines 14-23).


Takimoto does not expressly disclose wherein the server computer 4 of Figure 4

is located in the printer.

Reilly, in the same field of endeavor of network printing systems discloses

wherein the print server resides within the printer (Column 1, lines 43-54).

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to have included the server computer 4 of Figure 4 in the printer of

Takimoto.

The suggestion/motivation for combining the printer and print server is to reduce

the cost (Column 2, lines 40-45; Reilly).

Therefore, it would have been obvious to combine the network interface of Reilly

with the network printing system of Takimoto to obtain the invention as specified in

Claim 11.

Regarding Claim 12:

Takimoto discloses a method of printing of claim 11, further comprising enabling

or disabling use of said imaging substances for said image data file based upon said

authorization data, provided said originator data matches at least one authorization

identifier (Column 5, lines 7-15).

Regarding Claim 14:

Takimoto discloses a method of printing of claim 11, wherein said memory is a

non-volatile memory (Column 6, lines 38-41; Note: Figure 2, Steps S4, S5 and S11

clearly imply non volatile memory).

Regarding Claim 15:

Takimoto discloses a method printing of claim 11, wherein said authorization

data stored in memory (Column 6, lines 38-41) is stored in a look-up table (See Figures

3a and 3b).

Regarding Claim 17:

Takimoto discloses a method of printing of claim 11, wherein said origination

identifier includes at least one of a user identifier (Column 3, lines 54-58) and computer

identifier (Column 6, lines 59-67).

Regarding Claim 18:

Takimoto discloses a method of printing of claim 11, wherein said receiving is received from a client computer over a network Column 4, lines 31-36).

Regarding Claim 19:

Takimoto discloses a method of using a print device (e.g., Printer 5 in Figure 4; See embodiment described in Column 6, lines 28-32) on a print medium, comprising the steps of:

receiving at said printer an image data file (e.g., Data files stored in File Device 43 in Figure 4) from an originator, said image data file including at least one origination identifier (Column 3, lines 54-58);

comparing said at least one origination identifier with authorization data stored in memory (File device 43 in Figure 4), said authorization data including at least one authorization identifier corresponding to at least one enable property (e.g., Figures 3a and 3b) for a consumable; and

performing an operation (e.g., Print Processing Operation S10 in Figure 2) requiring said consumable provided said consumable is enabled for said originator (Column 6, lines 14-23).

Takimoto does not expressly disclose wherein the server computer 4 of Figure 4 is located in the printer.

Reilly, in the same field of endeavor of network printing systems discloses wherein the print server resides within the printer (Column 1, lines 43-54).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included the server computer 4 of Figure 4 in the printer of Takimoto.

The suggestion/motivation for combining the printer and print server is to reduce the cost (Column 2, lines 40-45; Reilly).

Therefore, it would have been obvious to combine the network interface of Reilly with the network printing system of Takimoto to obtain the invention as specified in Claim 19.

Regarding Claim 20:

Takimoto discloses a method of claim 19, wherein said consumable comprises one of toner, ink, staples and media type (See Figures 3a and 3b).

Regarding Claim 21:

Takimoto discloses a method of claim 19, further comprising the steps of:

overriding at least one said enable property stored in said memory (Column 5, lines 40-42); and

operating said printer with an availability of said consumable corresponding to said override (Column 5, lines 43-45).

Regarding Claim 22:

Takimoto discloses a method of using a print device (Column 2, lines 39-48),

comprising the steps of:

receiving a function request from an originator (Print Request Step 2 in Figure 2),

said request including at least one origination identifier (Column 3, lines 54-58);

comparing (Column 3, lines 63-66) said at least one origination identifier with

authorization data stored in memory (File device 43 in Figure 4), said authorization data

including at least one authorization identifier corresponding to at least one enable

property (Figures 3a and 3b) for a function; and

performing said function (e.g., Print Processing Operation S10 in Figure 2),

provided said function is enabled for said originator (Column 6, lines 14-23).


Takimoto does not expressly disclose wherein the server computer 4 of Figure 4

is located in the printer.

Reilly, in the same field of endeavor of network printing systems discloses

wherein the print server resides within the printer (Column 1, lines 43-54).

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to have included the server computer 4 of Figure 4 in the printer of

Takimoto.

The suggestion/motivation for combining the printer and print server is to reduce

the cost (Column 2, lines 40-45; Reilly).

Therefore, it would have been obvious to combine the network interface of Reilly

with the network printing system of Takimoto to obtain the invention as specified in

Claim 22.

3.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.      Claims 3-4, 8, 13 and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Takimoto in view of Reilly and further in view of Alegria et al. (US

6,768,877).

Regarding Claim 3 and similar claim 13:

    - Takimoto and Reilly discloses the method of printing of claims 1 and 11, however

Takimoto and Reilly do not disclose expressly wherein said imaging substances include

cyan toner, magenta toner and yellow toner.

Alegria et al. in the same field of endeavor of managing the security of a printer

on a network, discloses wherein said imaging substances include cyan toner, magenta

toner and yellow toner (Column 2, lines 61-66).

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to have included the cyan toner, magenta toner and yellow toner of

Alegria et al. in Takimoto and Reilly's network printer.

The suggestion/motivation for doing so would is to exercise control over who may and may not access a printers consumables. Color printing is costly and preventing certain users from accessing this feature will save money by making the toner last longer.

Therefore, it would have been obvious to combine the cyan toner, magenta toner and yellow toner of Alegria et al. in Takimoto and Reilly's network printer to obtain the invention as specified in claims 3 and 13.

Regarding Claim 4:

Takimoto and Reilly discloses the method of printing of claim 1, however Takimoto and Reilly do not disclose expressly wherein said imaging substances include cyan ink, magenta ink and yellow .

Alegria et al. in the same field of endeavor of managing the security of a printer on a network, discloses wherein said imaging substances include cyan ink, magenta ink and yellow ink (Column 2, lines 61-66 and Column 3, lines 33-36).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included the cyan ink, magenta ink and yellow ink of Alegria et al. in Takimoto and Reilly's network printer.

The suggestion/motivation for doing so would is to exercise control over who may and may not access a printers consumables. Color printing is costly and preventing certain users from accessing this feature will save money by making the toner last longer.

Therefore, it would have been obvious to combine the cyan ink, magenta ink and yellow ink of Alegria et al. in Takimoto and Reilly's network printer to obtain the invention as specified in claim 4.

Regarding Claim 8 and similar Claim 16:

Takimoto and Reilly discloses the method of printing of claims 1 and 11, however Takimoto and Reilly do not disclose expressly wherein said memory is a flash memory.

Note: Takimoto; Column 6, lines 38-41; Figure 2, Steps S4, S5 and S11 imply non volatile memory but not explicitly.

Alegria et al. in the same field of endeavor of limiting access to imaging devices on a network, discloses wherein said memory is a flash memory (Column 3, lines 56-59).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included the flash memory of Alegria et al. in Takimoto and Reilly's network printer.

The suggestion/motivation for doing so would is to have a non-volatile memory which does not need power to maintain the information stored in the Flash memory. Flash memory can be erased and reprogrammed and offers fast access times and costs far less than EEPROMs.

Therefore, it would have been obvious to combine the flash memory of Alegria et al. in Takimoto and Reilly's network printer to obtain the invention as specified in claims 3 and 13.

1.      Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takimoto

in view Reilly and further in view of Phillips et al. (US 2002/0186406).

Regarding Claim 5:

Takimoto discloses the method of printing of claim 1, except wherein said

imaging substances are waxes.

Phillips et al., in the same field of endeavor of monitoring consumable print

media, discloses wherein said imaging substances are waxes.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to have included the wax marking agent of Phillips et al. in Takimoto's

network printer.

The suggestion/motivation for doing so would is to exercise control over who may

and may not access a printers consumables.  Thermal wax printing technology works

well for businesses that need to produce large quantities of transparencies for colorful

business presentations but this kind of printing is costly and preventing certain users

from accessing this feature will save money by making the wax last longer.

### *Conclusion*

2.      The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Tang et al. (US 6,160,629) discloses an image forming device

that is capable of storing a print job temporarily or permanently to generate multiple
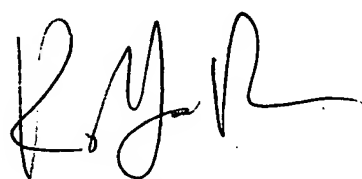
copies from a single transmission of one copy from a document generator at the time of

the initial transmission or at any time after the initial transmission.


Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Neil R. McLean whose telephone number is 571.

270.1679. The examiner can normally be reached on Monday through Friday  7:30AM-

5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, King Poon can be reached on 571.272.7440. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. McLean
09/24/2007

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